

### **III. REMARKS/ARGUMENTS**

#### **A. STATUS OF THE CLAIMS**

Claims 1-17 are pending. Claims 1-17 stand rejected. Applicants respectfully request reconsideration of the rejections of claims 1-17 for at least the following reasons.

#### **B. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e)**

Applicants note with appreciation the Examiner's vacation of the final rejection mailed August 7, 2006. Nevertheless, claims 1-17 stand rejected as allegedly anticipated by U.S. Patent No. 6,726,690 to Eckman. Specifically, the Office Action asserts:

Eckman discloses a various embodiments of an enucleation device comprising a proximal end, a distal end comprising a cutting cap, e.g. 23, comprising a plurality of deformable blades, 26, and a flexible shaft, e.g. 18, between the proximal end and the cutting cap, wherein the shaft comprises an axial guidewire lumen between the proximal end and the distal end, where the plurality of deformable blades can cut material in a space when the blades not deformed, i.e. the blades are partially retracted, after accessing the space through a passage while the blades are deformed and where the passage has a smaller cross-sectional area than the lateral cross-sectional area of the undeformed blades while the blades are cutting the material (see figures 1-7, column 5, lines 15-26 and column 8, lines 28-39)[.]

Office Action, Page 2 (emphasis added). Applicants respectfully disagree.

In order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."); see also Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) ("The

identical invention must be shown in as complete detail as is contained in the . . . claim.”). Claim 1 of the present application recites:

1. An enucleation device comprising:
  - a) a proximal end;
  - b) a distal end comprising a cutting cap comprising a plurality of deformable blades; and
  - c) a shaft between the proximal end and the cutting cap;  
where the plurality of deformable blades can cut material in a space when the blades not deformed, after accessing the space through a passage while the blades are deformed; and  
where the passage has a smaller cross-sectional area than the lateral cross-sectional area of the undeformed blades while the blades are cutting the material.

Appl’n, Claim 1. Contrary to the Office Action’s assertion, Eckman does not disclose the claimed “plurality of deformable blades.” Instead, in describing the blades, Eckman discloses that its blades are rigid:

The blades 26 are preferably formed of a hard, bio-compatible metal such as stainless steel, titanium, nickel, metal alloy, or the like. But, the blades 26 can be formed of other materials. It should be noted that the blades 26 are rigid. Each blade 26 preferably has an asymmetrical shape as best shown in FIGS. 4-5; however, the blades 26 may be other shapes without departing from the broad scope of the present invention. Preferably, the blades are generally convexly-shaped proximate the at least one sharp edge 32 thereby allowing the blades 26 to naturally find the most concave portions 100a or 100b of a particular vertebra 100.

Eckman, Col. 7, ll. 34-44. Eckman’s rigid blades are not deformable blades. Therefore, Eckman does not disclose all limitations of the claimed invention, and Applicants respectfully request that the rejection of claims 1-17 rejection be withdrawn.

#### IV. CONCLUSION

Applicants respectfully submit that the application is in condition for allowance. Applicants believe that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,  
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